



Attorney's Docket No. 45676P001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application for:

Steven R. Mitchell

Serial No. 09/528,466

Filed: March 17, 2000

For: A PURCHASE COORDINATOR FOR
ELECTRONIC COMMERCE

Examiner: Robert M. Pond

Art Unit: 3625

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DECLARATION PURSUANT TO 37 C.F.R. § 1.131

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

I, Steven R. Mitchell, hereby declare that:

1. I am a citizen of the United States of America.
2. I currently reside at 401 Nineteenth Street, Manhattan Beach, California 90266.
3. I am the inventor of the subject matter of the above-identified patent application.
4. I have reviewed U.S. Patent No. 6,263,317 B1 issued to Sharp et al (the "Sharp" patent) which was filed on December 1, 1998. The Examiner has cited the Sharp patent against the claims of the above-identified application.
5. The invention disclosed and claimed in the above-identified patent application was conceived in the United States of America well before December 1, 1998, as evidenced by the attached section of a deposition of Russell Frederick Lesser ("Document A"). In the deposition Mr. Lesser states under oath that I had discussed the present invention referred to as the

“purchase coordinator” with him at a dinner at the Biltmore Hotel on December 12, 1997. See Document A, page 18 line 4 through page 19 line 7 and page 21 lines 13 through 19. The actual conception was prior to December 12, 1997, and at least as early as March 1, 1997. This deposition was taken on August 13, 2001 in relation to litigation between myself and Jean Kasem and Little Miss Liberty Round Crib Company, Inc. This litigation was related to theft of trade secrets by conversion of the computer on which I was developing the invention.

6. Between its conception and its constructive reduction to practice by the filing of the above-identified patent application on March 17, 2000, I engaged in and directed development of the invention in a diligent effort to reduce the invention to practice. Because the development of the invention was not undertaken in the course of my employment, development occurred during my available free time. The invention as claimed was reduced to practice by being implemented and fully operational at least as early as August 1998. This implementation utilized a database program that offered inadequate speed and scalability. The invention was subsequently converted to utilize an Oracle database starting in August 1998 to provide the needed speed and scalability. During the conversion to Oracle, files were transferred to a Sun Sparc 5 computer named Matthew by a file transfer protocol application. Logs of the transferred files dated November 9, 1998 are presented as “Document B.” A set of Oracle table creation scripts dated November 24, 1998 recovered from a tape back up file documents part of the implementation of the invention (“Document C”). Partially recovered perl scripts and Java Source files (“Document D”), screenshots of generated webpages and webpage illustrations (“Document E”) and database data (“Document F”) from the invention written prior to December 1, 1998 further demonstrate the implementation of the concepts of the invention. Further sets of Documents each with a labeled FTP transfer log and corresponding copies of each of the files transferred to Matthew are includes as “Document G,” “Document H” and “Document J”. These documents demonstrate the extent of the implementation of the invention including the inventive concepts thereof as of November 29, 1998. A log file labeled '4' in "Document G" demonstrates that work on the database began at least as early as August 3, 1998. Work on the invention progressed as demonstrated by the updated Oracle database scripts dated

January 10, 1999 ("Document K") and the Oracle Database access logs from Matthew ranging from November 19, 1998 until July 24, 1999 ("Document L").

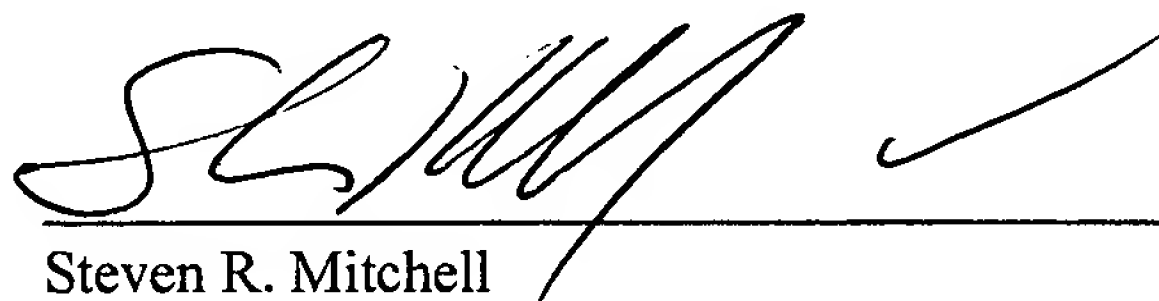
The actual programming of the invention was temporally halted due to the loss of access to a Sun Sparc Ultra 5 computer onto which primary development had been transferred. The loss of access began after May 25, 1999, and continued during subsequent litigation related to its disposition. This is documented in the attached Declaration of Howard I. Grapek dated October 2, 1999, ("Document M") in which Mr. Grapek states that the Sun Sparc Ultra 5 computer used for the development of the invention was shipped to me and subsequently he acted with Jean Kasem to hide the location of this computer from me. See Document L, paragraphs 5, 6 and 24-25. A Letter to Jean Kasem dated June 16, 1999, ("Document N") further clarifies that the Sparc Ultra 5 computer mentioned contained the code and data of the invention referred to in the Letter as the asset "getting ready for market." See Document N, page 1, paragraph 3. The invention as claimed was again reduced to practice by being implemented and fully operational on the Sparc Ultra 5 at least as early as May 1999 prior to the loss of the Sun Sparc Ultra 5 after May 25, 1999. The implementation of the invention on the Sun Sparc Ultra 5 was improved in terms of speed and scalability over previous implementations. Further, the scope of the project at the time I lost access to it is attested to in a deposition of Howard I. Grapek taken on May 8, 2001, in relation to the above-mentioned litigation ("Document O") wherein he states that I installed a database with many hundreds of tables. This installation occurred about January 5, 1999. See Document O, page 298 lines 6-23 and page 303 lines 4-19. Also see Document N, page 301 line 30-page 302 line 5 regarding the transfer of code from Matthew to the Sun Sparc Ultra 5. The expert testimony of Wayne B. Norris dated July 9, 2002, prepared in relation to the above-mentioned litigation ("Document P"), documents that the Sun Sparc Ultra 5 computer was reformatted and all data thereon lost on May 25, 2000, within five days of the date the complaint in the above-mentioned litigation was served and at which time the computer remained out of my possession. See Document P, page 2, section 1 of the Sequence of Events. This computer contained the only copy of the data and code related to the invention on that date.

7. The claimed invention was reduced to practice in August of 1998 and was subsequently instantiated and operational in Oracle by May of 1999. Therefore, the conception and diligence towards reduction to practice of the invention disclosed and claimed in the above-identified patent application occurred prior to the earliest priority date of the Sharp patent.

8. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above-identified application or any patent issued thereon.

Respectfully submitted,

Dated: 6/14/03



Steven R. Mitchell